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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 10/519,173 | 04/19/2005 | Glenn D. Prestwich | 21101.0036U2 | 5246 |
| 25213 | 7590 | 06/08/2007 | | |
| HELLER EHRMAN LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506 | | | EXAMINER LUKTON, DAVID | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1654 | |
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| | | | 06/08/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/519,173 | Applicant(s) PRESTWICH ET AL. | |
| | Examiner David Lukton | Art Unit 1654 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-115 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 10-12 and 15-115 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 7-9, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to: See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Pursuant to the directives of the response filed 3/27/07, claim 1 has been amended. Claims 1-115 remain pending. Claims 1-3, 7-9, 13, 14 are examined in this Office action; claims 4-6, 10-12, 15-115 remain withdrawn from consideration.

Applicants' arguments filed 3/27/07 have been considered and found persuasive in part. With the exception of the rejection over Janda ('372), the previously imposed rejections are withdrawn.

In this Office action, claims 1-3 are rejected, and claims 7-9 and 14 are objected to because of their dependence on rejected claims.



The following is a quotation of 35 USC, §103 which forms the basis for all obviousness rejections set forth in the Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

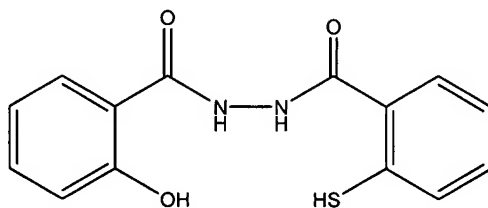
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 1 and 2 are rejected under 35 U.S.C. §103 as being unpatentable over

Zhao (*J Med Chem* **40**, 937-941, 1997).

Zhao discloses (page 939) the following compound:



This anticipates claim 1 when the substituent variables are as follows:

Y = phenol

L = -C₆H₄-

Q = -SH

. . . .

Claims 1 and 2 are rejected under 35 U.S.C. §103 as being unpatentable over Young (USP 4767745).

Young discloses compound VIII at cols 7-8 (second-to-last structure). This is encompassed by claim 1 when the variables are as follows:

Y = leukotriene ;

L = polyalkylene

Q = maleimide.



Claims 1 and 3 are rejected under 35 U.S.C. §103 as being unpatentable over Janda (USP 6664372).

As indicated previously, Janda discloses (col 4, lines 51-57) a compound which contains the requisite dicarbonyl hydrazine group. At one terminus of the compound there is a variable "Rx"; it is recited at col 4, line 62 that this Rx group can be the side chain of cysteine.

In response to the foregoing, applicants have argued in effect that if one takes a macromolecule, and attaches a hydrazide group to it, or several hydrazide groups to it, the property of being a macromolecule is somehow lost. Or alternatively, that the term "Y" in instant claim 1 excludes hydrazide groups. However, applicants are not correct. There is no authority to which applicants can point that would asserts that chemists are forbidden from describing macromolecules which contain hydrazide groups as macromolecules. Of course, if there is descriptive support for it, applicants can amend claim 1 to exclude the possibility that "Y" can contain a hydrazide group.

As matters currently stand, however, the claims are rendered obvious.



No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read 'D. Lukton', is positioned above the printed name.

**DAVID LUKTON, PH.D.
PRIMARY EXAMINER**